

Appln. No. 09/429,585
Communication dated Aug. 8, 2003
Response to Office Action dated May 8, 2003

REMARKS

As an initial matter, the Examiner and his supervisor, Mr. Cabeca, are thanked for the courtesies extended during a personal interview on June 17, 2003. A summary was prepared by the Examiner and provided to Applicant and Applicant's representative at the conclusion of the interview. During that interview, newly submitted claims, which have not been entered, were discussed for consideration as well as the claims presently pending in the case. The Examiner graciously indicated that upon receipt of a response after final, the arguments presented therein would be given further consideration in light of the discussions that took place on June 17, 2003. Accordingly, Applicants remarks and further arguments with respect to the May 8, 2003 Final Rejection are set forth below.

With respect to claims 61-63 and 66, which stand rejected under 35 U.S.C. §102(e) as being anticipated by Burner, the undersigned respectfully reiterates that Burner is not a proper anticipatory reference, nor does Burner render claims 61-63 and 66 obvious. As discussed, and, it is respectfully submitted, as the Examiner recognized during the interview, the invention of Burner is in fact a piece of client software that is described as providing a floating toolbar that provides additional functionality to a user as the user traverses the internet. The Examiner sets forth in the Final Rejection that the Burner toolbar could be displayed "along with" the internet browser toolbar while the browser is activated regardless of the internet sites to which the computer is connected. This fact does not disclose or suggest the inventions claimed in claims

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61-63 and 66. The user toolbar of the inventions recited in those claims is displayed as part of the internet browser interface along with and in addition to the internet browser toolbar which is provided as part of the native browser interface. It is respectfully submitted, based upon the discussions held during the interview, that there is no dispute with the Examiner in connection with what the browser interface of an internet browser comprises. The subject inventions of claims 61-63 and 66 recite additional functionality provided via a user toolbar that is displayed "as part of the internet browser interface along with and in addition to the internet browser toolbar". The Burner reference merely teaches a floating toolbar in a separate window, which is not a user toolbar that is displayed as part of the internet browser interface along with and in addition to the native internet browser toolbar. In connection with the Examiner's comments at the interview that the Burner toolbar could possibly be "dragged" across the screen and positioned in the space occupied by the internet browser, this is not in any way a user toolbar that is displayed as part of the internet browser interface. Were a user to perform the suggested repositioning of the Burner toolbar, the Burner toolbar would in fact necessarily obscure either a portion of the native browser interface or the internet content being viewed with the browser, a clear disadvantage and a shortcoming overcome by the invention of claims 61-63 and 66. Burner in no way teaches or suggests a user toolbar as part of the browser interface. Thus it is respectfully submitted that the Examiner should reconsider his §102 objection as to Burner, since a toolbar that floats in a window separate and apart from a browser interface does not teach or

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suggest the inventions as presently claimed. Nor does Burner render the inventions of claims 61-63 and 66 obvious since Burner is completely devoid of a recognition of the problem and solution recited by those claims, namely a user toolbar with additional functionality as part of the browser interface along with and in addition to the internet browser toolbar. Since Burner has no teaching or suggestion of the desirability of such a feature, Burner also cannot render claims 61-63 and 66 obvious.

Further, with respect to the Examiner's contention that the fact that the Burner toolbar could be implemented as "an extension of the browser or as browser plug-in software" also anticipates claims 61-63 and 66, this was also discussed at the interview. It is respectfully submitted that since Burner teaches client software, the fact that it could be implemented as an extension of the browser or as a browser plug-in does not teach that the Burner toolbar should be implemented as part of the native browser interface as is recited in claims 61-63 and 66. Thus, it is respectfully submitted that the fact the Burner reference discloses that client software can be implemented as a browser extension or browser plug-in does not of itself teach the inventive claimed toolbar, which provides additional functionality in a user toolbar displayed as part of the browser interface along with and in addition to the native browser toolbar. Reconsideration of the rejection and allowance of claims 61-63 and 66 is earnestly requested.

With respect to claims 53, 77 and 84, and claims depending therefrom, the Examiner has rejected those claims as obvious under 35 U.S.C. §103 as being unpatentable over Burner et al.

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and the Alexa Internet Website reference (web.archive.org/web/19980209015002/...). The undersigned submits that the arguments presented above with respect to Burner are applicable to the inventions of claims 53, 77 and 84 as well, as well as the claims depending therefrom, which all stand rejected on obviousness grounds. The Examiner, in combining the references, indicates that the Burner reference fails to disclose providing access to the client software disclosed by Burner at a predetermined internet site and making that the software available for download by the user. However, the Examiner submits that the Alexa Internet Website reference describes providing access to specific software for "adding a user toolbar to their internet browser interfaces". It is respectfully submitted that the Alexa Internet Website reference does not describe downloading a user toolbar that may be added to and become part of the internet browser interface, but rather the reference discloses a software tool that operates "in parallel with, and independently of Web browsers, and is displayed as a toolbar on the user's desktop". (Alexa Internet Website reference, page 1, paragraph 4). It is respectfully submitted that this does not teach that the Alexa toolbar is or can be a toolbar that is added to an internet browser interface of the existing browser on the user's computer, which is the aim of the inventions recited in claims 53, 77 and 84. Indeed, Alexa is the assignee of the Burner reference which, as pointed out above, describes the Alexa toolbar as existing in a separate window which floats on the user's desktop and is not described as operating as part of the native browser interface. Thus the Alexa Internet Website reference is describing the same functionality as Burner, which is

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merely a floating toolbar available in a window on a user's desktop and not as part of the internet browser interface, a distinguishing feature which sets apart the presently claimed inventions. Thus, even if the hypothetical combination of those references were made, the fact that the Burner or Alexa software is downloadable still would not meet all of the limitations of the presently argued claims because the downloaded Burner/Alexa toolbar is still described as a floating, window-based desktop toolbar that is not presented as part of the native internet browser interface as claimed. Thus, it is respectfully submitted that the proposed combination suggested by the Examiner of the Burner and Alexa Internet Website reference does not teach or suggest the claimed user toolbar which is displayed as part of the browser interface. The proposed hypothetical combination of the Burner and Alexa Internet Website references merely provides a downloadable window-based toolbar that, as recognized by the Examiner, may be repositioned by the user, but if the Burner toolbar were to be repositioned in the manner suggested by the Examiner, it would obscure part of the native browser interface or the internet content, under which circumstances it would be demonstrably not be part of the internet browser interface as claimed. Thus, it is respectfully submitted that the proposed combination of the Burner and Alexa Website references upon which the Examiner relies for rejecting claims 53, 54, 56, 57, 77, 78, 79, 81, 82, 84 and 85 under 35 U.S.C. §103 is untenable, and reconsideration of the Examiner's position and allowance of the claims is earnestly requested. Additionally, with respect to claim 85, it was discussed during the interview that the Examiner had taken official

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notice of the fact that browsers, upon loading, are frequently directed to a pre-programmed "homepage" or predetermined website. Applicant did not traverse taking official notice of that fact per se, since such functionality is recognized in the prior art. However the undersigned respectfully submits that the Applicants did adequately traverse such official notice with respect to any suggestion that a browser going to a predetermined homepage upon loading in any way teaches or suggests that a user toolbar which is not part of the native internet browser should go to a predetermined homepage upon loading. Thus, as recited in claim 85, the action taken upon activation of the browser is not the action of directing the browser to a predetermined homepage but rather the user toolbar being activated with the native internet browser and the user toolbar being directed to a predetermined internet site. Thus, the official notice taken by the Examiner is not an adequate anticipatory fact that would, in addition to the Burner or Alexa website reference, teach the features as recited in presently pending claim 85. It is respectfully requested that the Examiner's position with respect to claim 85 be reconsidered in light of the arguments above and the discussions had at the interview, and claim 85 be passed to allowance.

With respect to claims 55 and 80, which stand rejected as unpatentable under 35 U.S.C. §103 based on the combination of Burner, the Alexa Internet Website reference and Ko et al., it is respectfully submitted that the features described above with respect to claim 53 (from which claim 55 depends) and claim 77 (from which claim 80 indirectly depends) are applicable to these claims as well. Thus the fact that Ko teaches the use of active scripting to implement custom

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software does not teach or suggests the deficiencies in the hypothetical combination of Burner and the Alexa Internet Website reference as proposed by the Examiner. Thus, it is respectfully requested that the Examiner reconsider his position with respect to claims 55 and 80 for the reasons set forth above in connection with the claims from which claims 55 and 80 depend.

Turning next to the rejection of claims 58 and 83, these claims stand rejected under 35 U.S.C. §103 as being unpatentable over the combination of Burner et al., the Alexa Internet Website reference, both of which were discussed above, and further in view of the Microsoft Internet Explorer 4 reference. As discussed during the interview, and as set forth in the Final Rejection, the Examiner's position is that Microsoft Internet Explorer 4 contains a search button as part of a native browser toolbar, and as set forth in the final Office Action, the Examiner states that the Internet Explorer 4 reference discloses in Fig. 3.11 on page 42 "an entire browser toolbar dedicated to searching at a predetermined internet site regardless of the site to which the browser is connected". As discussed during the interview, and as reiterated here, the undersigned emphatically traverses such a characterization of the Internet Explorer 4 capability. As set forth in the Internet Explorer 4 reference, and as is clearly seen in the cited figure, the Internet Explorer 4 reference does not in any way disclose a user toolbar having a search window that enables the user to initiate a search at a predetermined internet site, that site being the site from which the user toolbar was downloaded. Rather, as described in the Microsoft Internet Explorer 4 reference, what exists in the depicted Internet Explorer browser interface is a search button as

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part of a native browser toolbar. When the user clicks on the search button, a window in the browser is opened and the user is presented with a drop down menu window, which drop down menu contains links to internet sites that provide internet search capability. After a user selects the particular internet site that the user wishes to conduct a search through, the search page of the internet site selected by the user is displayed in the browser window as a webpage. The user may then enter search terms in the search window provided as part of the HTML page provided by the search website selected. Thus, the claimed functionality of claims 58 and 83, which recite the capability of initiating a search via a search window provided as part of a user toolbar displayed as part of the browser interface is significantly different from the ability to enter a search term on a downloaded internet webpage from a search engine, as was and still is commonly done. There is simply nothing in any of the references combined by the Examiner, specifically the Burner reference, the Alexa Internet Website reference, and the Internet Explorer 4 reference, that in any way teaches or suggests the desirability of implementing the extremely efficient functionality of incorporating a search window as part of a user toolbar as part of the browser interface. As pointed out during the interview, the functionality as claimed in claims 58 and 83 eliminates the necessity for the user to first click on a search button, then select a search website through a drop down menu, receive a downloaded web page, and then initiate a search in the search field provided as part of a web page downloaded by the internet search site selected by clicking in the drop down menu. This is an inordinate number of steps to take to execute a search, as compared

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to the ability to enter a search directly into a search window provided in a user toolbar that is provided as part of the browser interface. Clearly the Examiner must agree that in internet space, saving "clicks" provides significant advantages over techniques that require more complex navigation. The inventions of claims 58 and 83 provides significant advantages over the technique presented in the proposed three-reference combination recited by the Examiner. The desire for improved efficiency is not, however, sufficient motivation for making the combination the Examiner relies upon. It is respectfully submitted that none of the three references provides adequate motivation or teaching or even suggestion for the inventions recited in claims 58 and 83, which make the search window part of an added user toolbar presented as part of the browser interface, thereby eliminating the burdensome steps described in the Internet Explorer 4 reference. Additionally, even if the proposed combination of references made by the Examiner were proper (a fact not conceded), the combination would not yield the claimed invention of claims 58 and 83. Since the Burner reference and the Alexa Internet Website reference do not even provide any teaching whatsoever that a user toolbar should contain a search window, and since the Microsoft Internet Explorer 4 reference also does not teach or suggest a search window as part of a user toolbar but rather only teaches a set of navigation steps through which a user may access a search window found as part of a search web page provided by an internet site, it is respectfully submitted that claims 58 and 83 are clearly patentable over the proposed

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combination and reconsideration of the Examiner's position and allowance of claims 58 and 83 is earnestly requested.

With respect to claim 64, the same arguments presented above with respect to claims 58 and 83 are applicable, although, as the Examiner points out, the Alexa Internet Website reference is not implicated in the combination. Nonetheless, for the same reasons presented above in connection with the hypothetical combination of the three references, since the teaching upon which the Examiner relies is exclusively found in the Internet Explorer 4 reference, the undersigned submits that the arguments presented above with respect to claims 58 and 83 apply equally to claim 64, and for those reasons the rejection of claim 64 under U.S.C. §103 is untenable and should be withdrawn as well.

Turning next to the rejection of claims 59 and 60, these claims stand rejected as being unpatentable under 35 U.S.C. § 103 based upon the combination of Burner, the Alexa Internet Website reference, and MacNaughton et al. Claims 59 and 60 depend from claim 53, and thus, the arguments made above in connection with claim 53 are equally applicable here. With respect to the features absent from claim 53, the MacNaughton reference does not provide any teaching or suggestion of the claim features missing from base claim 53 as discussed above. Thus, for that reason alone, the rejection of claims 59 and 60 should be withdrawn. Further, MacNaughton does not, as the Examiner suggests in the Final Rejection, teach storing user information that is used to populate a toolbar. It is respectfully submitted that a review of columns 9 and 10 of the

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MacNaughton reference as cited by the Examiner reveals that the “user information” referred to by the Examiner (which it is believed is discussed at column 9, lines 53 through column 10, line 16) are capabilities that are provided through the web pages a community member interacts with, and not with a user toolbar as claimed in the subject claims. Thus, the proposed hypothetical three-reference combination upon which the Examiner relies to reject claims 59 and 60, it is respectfully submitted, does not result in a teaching or suggestion of all of the claim limitations of claims 59 and 60 or even claim 53 from which these claims depend. Thus, it is respectfully urged that the rejections of claims 59 and 60 also be withdrawn.

With respect to the rejection of claim 65, it is respectfully submitted that this claim is patentable for the same reasons as presented above in connection with claim 62 from which claim 65 depends. The arguments presented with respect to claims 55 and 80 above are also applicable to claim 65. It is respectfully urged that the rejection of claim 65 be withdrawn.

With respect to claim 67, it is respectfully submitted that the arguments presented above with respect to claim 62 as well as claims 59 and 60 and 85 as set forth above, are equally applicable to the rejection of claim 67, and for those reasons the rejection of the 35 U.S.C. § 103 with respect to claim 67 should also be withdrawn.

With respect to claim 68, this claim stands rejected under 35 U.S.C. §103 as being unpatentable over the combination of the Burner, MacNaughton, and Guyot references. Claim 68 depends, through claim 67, from claim 62, and it is respectfully submitted that claim 68 is

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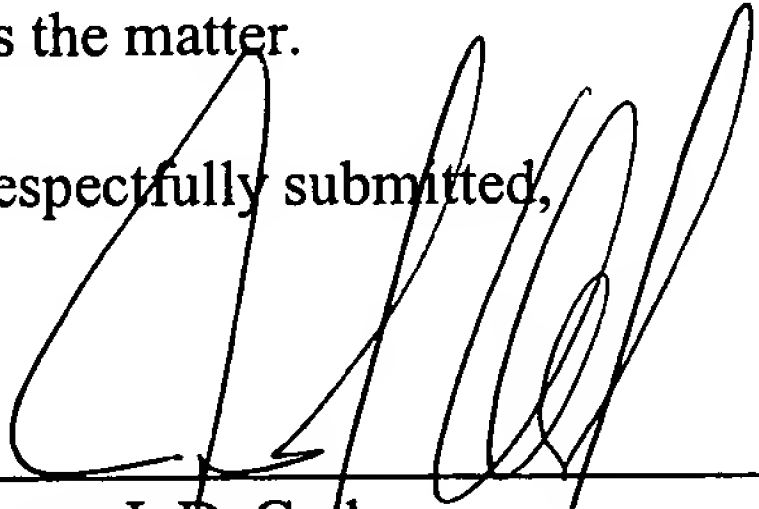
allowable for the reasons presented above with respect to those claims from which claim 68 depends. Additionally, the Guyot reference does not, as the Examiner sets forth, teach or suggest that "it is well known to periodically reconnect to an Internet server to download the most recent information and apply it to an application interface". It is respectfully submitted that the Guyot reference reveals that the information being "updated" in Guyot is related to pop up advertisements and not an application interface, and especially not a browser interface having as part thereof a user toolbar with interface objects therein as is recited in the invention of claim 68. Thus, it is respectfully submitted that there is no teaching or suggestion in Guyot to periodically connect to a predetermined internet site that provides a downloadable, updateable user toolbar that exists as part of the native browser interface in addition to the native browser toolbar, as is claimed in claim 68. Accordingly, for these reasons, it is respectfully submitted that the rejection to claim 68 should be withdrawn.

With respect to claim 86, which depends from claim 53 through claim 85, it is respectfully submitted that claim 86 is allowable for the reasons set forth in connection with the claims from which claim 86 depends. It is further submitted that the arguments presented directly above with respect to claim 68 are equally applicable to claim 86, and for these reasons it is respectfully urged that the Examiner reconsider his position and withdraw the rejection of claim 86 under 35 U.S.C. §103 as well.

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Once again, the undersigned thanks the Examiner for the courtesies extended during the interview, and hopes the Examiner found the interview process helpful in pointing out the specific novel features of the inventions as presently claimed, and why the prior art cited by the Examiner does not teach or suggest the inventions as presently claimed. Again, it is respectfully submitted that the inventions described in the claims discussed above, which each relate to a user toolbar presented as part of the browser interface, are nowhere taught or suggested in the prior art of record. It is hoped that in light of the interview and the above remarks the Examiner will reconsider his position with respect to the pending claims and place them in condition for allowance. Should the Examiner not be inclined to do so, the Examiner is respectfully urged to call the undersigned at 212-806-5742 to discuss the matter.

Respectfully submitted,



James J. DeCarlo
Registration No. 36,120
Attorney for Applicants
STROOCK & STROOCK & LAVAN LLP
180 Maiden Lane
New York, New York 10038-4982
(212) 806-5400